

REMARKS

Reconsideration of the present application is respectfully requested. No claims have been added or canceled. Claims 1-18 stand rejected and are currently pending.

Claim Rejections – 35 USC § 101

Claim 1 was rejected under 35 USC § 101 because the claimed invention is directed to non-statutory matter. Applicants respectfully traverse the rejection and hereby request reconsideration.

MPEP 2106 states “[o]ffice personnel are to give claims their broadest reasonable interpretation in light of the supporting disclosure. Limitations appearing in the specification but not recited in the claim are not read into the claim.” MPEP 2106 also states “[o]ffice personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered.”

With regard to claim 1, the Examiner rendered the rejection in violation of MPEP 2106. The Examiner did not give the broadest reasonable interpretation to the claim. The Examiner read limitations in the specification into the claim by stating “a claimed signal”. Applicants are not claiming a signal in the claimed invention. The Examiner dissected the claim by stating isolated parts to render the rejection. Claim 1 is not directed to “a computer-readable media that stores computer-usable instruction.” Claim 1 is directed to “One or more computer-readable media having a tangible component, having computer-usable instructions embodied thereon for performing a method of printing cable-label records on a printing device, the method comprising: receiving search criteria for one or more cable-label records, wherein said cable-label records were previously stored in a storage component; identifying one or more records in said storage component corresponding to the search criteria; and providing a data stream that

when rendered by the printing device produces cable-label records displaying content of the identified records in a prescribed format.” The computer-readable media is expressly limited to a tangible embodiment by the claim itself. As such, the claim is limited to statutory material. Accordingly, withdrawal of the rejection is respectfully requested.

With further regard to claim 1, the Patent and Trademark Office issued interim guidelines to provide office personnel with guidance for handling computer-related inventions. However, MPEP 2106 states “[t]hese Guidelines do not constitute substantive rulemaking and hence do not have the force and effect of law.” Even if the guidelines are followed, the Examiner stated “A signal encoded with functional descriptive material does not fall within any of the categories of patentable subject matter.” This is an incorrect conclusion in view of the guidelines. The guidelines state “[w]hen functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases.” Therefore, claim 1 is directed to statutory subject matter. Again, withdrawal of the rejection is respectfully requested.

Claim Rejections – 35 USC § 102

Claims 1-7, 9-15, 17 and 18 were rejected under 35 USC § 102(b) as being anticipated by US Patent No. 5,280,251 to Strangio. Applicants respectfully traverse the rejections and hereby request reconsideration.

MPEP 2131 states “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” It further states “[t]he identical invention must be shown in as complete detail as is contained in the ... claim.”

With regard to claim 1, MPEP 2131 is not satisfied. The Examiner stated that the element “providing a data stream that when rendered by the printing device produces cable-label records displaying content of the identified records in a prescribed format” is anticipated by Strangio at column 13, lines 23-26. On the contrary, Strangio does not disclose providing a data stream to a printing device to produce cable-label records. Note the use of the term “data stream” and the use of the plural term “records.” In Strangio at column 13, lines 23-29, it states “[l]abel data is linked with the other cable information that is stored in the database, so that recall of match data will also make available label text associated with the match data. Printing a label requires a suitable printing device that can handle adhesive label forms, or paper of a proper size that can be inserted into a label holder that attaches to the cable.” No step for providing a data stream is disclosed in Strangio. Strangio never discloses how the match data gets to the printing device. For all that we know, the data could be placed on a floppy disk or carried manually to the printing device. Without such detail, the Examiner cannot read a limitation into Strangio to reject claim 1. Furthermore, no step for printing records (in the plural) is disclosed in Strangio. Strangio discloses printing a single label, not multiple labels. Applicants claimed invention discloses printing cable-label records. The Examiner cannot read a plural limitation into Strangio to reject claim 1. Accordingly, withdrawal of the rejection of claim 1 is respectfully requested.

With further regard to claim 1, the Examiner rejected claim 1 in the Office Action by stating “[a]s seen, each cable type in the database that contain continuity matrix, connector gender and type, a list of devices and applications is *a cable record*.” Applicants take exception to the Examiner’s reason for rejection. Applicants’ claimed invention involves “a cable-label record” and not “a cable record.” The two are very distinct. The Examiner’s statement may be

true for a “a cable record” but it is definitely not true for “a cable-label record.” In Strangio at column 1, lines 27-31, it states “it is impossible to differentiate certain cable types by appearance only. As a consequence, many cables that look right for an application and fit everything properly do not work.” Strangio indicates that a cable type refers to a physical characteristic of the cable, not a label. Therefore, a cable type information as disclosed by Strangio does not indicate a cable-label record. Again, withdrawal of the rejection of claim 1 is respectfully requested.

With regard to claim 9, Applicants’ arguments for claim 1 above are applicable to claim 9 as well. Accordingly, withdrawal of the rejection of claim 9 is respectfully requested.

With further regard to claim 9, Strangio does not teach “creating one or more cable-label records to be stored in a storage component” as found in Applicants’ claim 9. In Strangio at column 8, lines 58-64, it states “[t]o assist the Operator in characterizing and cataloging the many types of cables that may be encountered, a disk database is made available and contains the stored continuity matrix, connector types, and other information corresponding to many different cables.” The language in Strangio refers to a cable record but does not refer to a cable-label record. Nothing in Strangio discloses the manipulating or handling of a label or a record of the label. Applicants’ arguments regarding the distinction of a cable record and a cable-label record are applicable here. Again, withdrawal of the rejection of claim 9 is respectfully requested.

With regard to claim 15, Strangio does not teach “a cable-label records controller that receives the query result and converts the result into a prescribed format whereby the query result can be rendered on a printing device.” In Strangio at column 12, lines 56-60, it states “the Operator is asked to select a print mode 350 at which time he chooses one of four print

possibilities 351, or escapes the print function. The appropriate flag is set within the program 352 to specify what is to be printed.” In looking at figure 5M in Strangio, the appropriate flag corresponds to the Operator selecting either a Wiring Diagram, Netlist, Continuity Matrix, or Label. Depending on which one of the four item is selected, the flag is set to print that item. For example, the Operator selects Continuity Matrix, then the flag is set to print Continuity Matrix. These actions do not anticipate Applicants’ claimed invention in claim 15. No controller is disclosed in Strangio. No controller that receives query results is disclosed in Strangio. No controller that converts the query results is disclosed in Strangio. Accordingly, withdrawal of the rejection of claim 15 is respectfully requested.

With regard to claim 18, Strangio does not teach “generating a cable-label records record in a structured format from the set of data.” In Strangio at column 8, lines 59-63 and elsewhere, no disclosure is made of generating a record of cable-label records as required by Applicants’ claimed invention. In addition, Strangio does not disclose any information related to formats whereas Applicants’ claimed invention requires that a record of the cable-label records be generated in a structured format. Accordingly, withdrawal of the rejection of claim 18 is respectfully requested.

With regard to claim 2, the Examiner has dissected the claim in violation of MPEP 2106. The Examiner rendered a rejection of claim 1 stating the “search criteria” was anticipated by Strangio at column 8, line 67 – column 9, line 1. This portion of Strangio referred to Step 216, Function C relating to searching a disk for a match. Now, the Examiner rendered a rejection of claim 2 stating “a first search parameter” and “a second search parameter” were anticipated by Strangio at column 10, lines 46-54. This portion of Strangio referred to Step 216, Function H relating to analyzing test data. MPEP 2131 states “[t]he

elements must be arranged as required by the claim.” This means that the “search criteria”, “a first search parameter”, and “a second search parameter” must be together in order to reject claim 2. As shown in Strangio, Function C and Function H are not together and do not relate to each other. The functions relate to entirely different and distinct actions. Accordingly, withdrawal of the rejection of claim 2 is respectfully requested.

Applicants submit that claims 3 and 10 are allowable at least by virtue of their dependency from allowable claims 2 and 9. Claims 4 and 11 are allowable at least by virtue of their dependency from allowable claims 3 and 10.

With regard to claim 12, Applicants’ arguments for claim 2 above are applicable to claim 12 as well. Accordingly, withdrawal of the rejection of claim 12 is respectfully requested.

With regard to claims 5 and 13, Applicants’ arguments for claim 2 above are applicable to claims 5 and 13 as well. No assembling step is disclosed in Strangio. Accordingly, withdrawal of the rejection of claims 5 and 12 is respectfully requested.

Applicants submit that claims 6 and 14 are allowable at least by virtue of their dependency from allowable claims 5 and 13.

With regard to claim 7, Applicants’ arguments for claim 1 above is applicable to claim 7 as well. No data stream is disclosed in Strangio. Accordingly, withdrawal of the rejection of claim 7 is respectfully requested.

Claim Rejections – 35 USC § 103

Applicants submit that the claimed invention is commonly owned as to each inventor.

Claims 8, 16 and 17 were rejected under 35 USC § 103(a) as being unpatentable over US Patent No. 5,280,251 to Strangio as applied to claims 1 and 15, and further in view of US Patent No. 6,721,414 to Rojas et al. Applicants respectfully traverse the rejections and hereby request reconsideration.

MPEP 2143.01 states “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” It also states “[i]f the proposed modifications or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious.”

In Strangio, a cable tester is disclosed. The cable tester is a hardware device with a series of interfaces for connecting cables to the cable tester. In Rojas, a cable manager is disclosed. The cable manager is a software module used to search and track telecommunications paths within a telecommunication system. As shown in Strangio and Rojas, there is no suggestion to combine. Applicants also submit that Strangio and Rojas are not combinable as Strangio deals with a hardware device that physically interfaces with cables and Rojas deals with a software module that analyzes telecommunications paths. The cable manager is never brought into physical contact with a cable, as in Strangio. Therefore, there is no suggestion or motivation to combine the references. Accordingly, withdrawal of the rejection of claims 8, 16 and 17 is respectfully requested.

Applicants also submit that claims 8, 16 and 17 are allowable at least by virtue of their dependency from allowable claims 1, 15 and 16.

CONCLUSION

No fee is believed due in connection with this Amendment, but the Commissioner is hereby authorized to charge any additional amount required or to credit any overpayment to Deposit Account No. 21-0765.

Respectfully submitted,

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